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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,351	03/27/2002	Dana Paul Gruenbacher	8278	1392

27752 7590 07/28/2003

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INTELLECTUAL PROPERTY DIVISION  
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CINCINNATI, OH 45224

EXAMINER
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PRUNNER, KATHLEEN J

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 07/28/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
10/089,351

Applicant(s)  
Gruenbacher et al.

Examiner  
Kathleen J. Prunner

Art Unit  
3751



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 22, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Mar 27, 2002 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on May 22, 2003 is: a) ☐ approved b) ☒ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## DETAILED ACTION

### *Drawings*

1. The proposed substitute sheets of formal drawings, filed on May 22, 2003 (Paper No. ), have been disapproved. The proposed substitute sheets of formal drawings have been disapproved since: (A) they constitute an incomplete set of the drawings, i.e., Figs. 34-37 and 42-45 are missing; (B) Fig. 51 should be bracketed to indicate that it constitutes a single entity; and (C) Fig. 58, showing a double set of dotted boxes, is inconsistent with the original Fig. 58, showing a single dotted box. A proper drawing correction is required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings **must show every feature** of the invention **specified in the claims**. Therefore, (A) the externally accessible opening, as called for by claims 1, 13 and 17; (B) the massaging structure or feature, as called for by claim 11; (C) the massaging structure or feature positioned behind the first external side, as called for by claim 11; and (D) the structures as called for by claim 12, must be shown or the features canceled from the claims. No new matter should be introduced or it will not be entered.

A proposed drawing correction is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. Applicant is required to submit a proposed drawing correction **in reply to this Office action** in order to avoid abandonment of the application. Any proposal by the applicant for amendment of the drawing to cure defects **MUST be embodied in a SEPARATE LETTER to the Draftsman**. See MPEP §608.02(r). The objection to the drawings will not be held in abeyance.

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4. Applicant is required to submit a proposed drawing correction in response to this Office action. Any proposal by applicant for amendment of the drawings to cure defects must consist of two parts:

- a) A separate letter to the Draftsman in accordance with MPEP § 608.02(r); and
- b) A print or pen-and-ink sketch showing changes in red ink in accordance with MPEP § 608.02(v).

IMPORTANT NOTE: The filing of new formal drawings to correct the noted defect may be deferred until the application is allowed by the examiner, but the print or pen-and-ink sketch with proposed corrections shown in red ink is required in response to this Office action, and may not be deferred.

### *Specification*

<sup>per</sup> 5. The disclosure is objected to because of the following informalities: (A) on page 3, in the paragraph beginning on line 11, “a first side having a first internal surface and a first external surface” has been described; however, the description beginning on line 14 of page 7 fails to describe what structure constitutes such a first side having a first internal surface and a first external surface; and (B) on page 3, in the paragraph beginning on line 11, “a second side having a second internal surface and a second external surface” has been described; however, the description beginning on line 14 of page 7 fails to describe what structure constitutes such a second side having a second internal surface and a second external surface. Appropriate correction is required.

6. The following informalities in the specification are noted: (A) on page 5, line 7, --the--<sup>o'up</sup> should be inserted before “mitt”;<sup>sup</sup> (B) on page 40, line 10, “acheating” should read --a heating--; and<sup>sup</sup> (C) on page 60, line 17, “53” should read --57--. Appropriate correction is required.

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dep of #12 entered

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 3 and 10 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an internal cavity that is accessible "through an opening" (note line 25 on page 8), does not reasonably provide enablement for "at least one . . . opening", as called for by claims 1, 13 and 17, which purports more than one opening. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

11. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

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claimed invention. Claims 1, 13 and 17 now call for “an activatable temperature changing element”. However, the original disclosure fails to describe or support such a temperature changing element. Hence claims 1, 13 and 17 are directed to new matter.

12. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a mitt to include “a heating and/or cooling element” (note lines 28-29 on page 33), does not reasonably provide enablement for “a temperature changing element”, i.e., an element capable of changing its temperature, for a mitt as called for by claims 1, 13 and 17. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

13. Claims 3 and 4 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The disclosure fails to support that the embodiment which utilizes the “temperature changing element” can be used for “cleaning, moisturizing, conditioning, or otherwise treating the skin, hair, or nails”, as called for by claim 3. The disclosure also fails to support that the embodiment which utilizes the “temperature changing element” can be used with a “product selected from the group consisting of face cleansers, body cleansers, toners, lotions, moisturizers, ointments, cosmetics/make-ups, medicaments, and related topically applied treatments”, as called for by claim 4.

14. Claims 4 and 5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 4 now calls for the product to be selected from the group consisting of face cleansers, body cleansers, toners, lotions, moisturizers, ointments, cosmetics/make-ups, medicaments, related topically applied treatments, “and combinations thereof”. However, the

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original disclosure fails to describe or support that combinations of face cleansers, body cleansers, toners, lotions, moisturizers, ointments, cosmetics/make-ups, medicaments, related topically applied treatments can be used. Hence claim 4 is directed to new matter.

15. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a massaging structure of “rotating or rolling balls/cylinders/rods” (note line 3 on page 53), does not reasonably provide enablement for “balls, cylinders, rods” as called for by claim 12. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

16. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a massaging structure of “three-dimensional patterns embossed, engraved, or otherwise formed in a solid material” (note lines 3-4 on page 53), does not reasonably provide enablement for three-dimensional patterns “embossed within” a solid material, three-dimensional patterns “engraved within” a solid material, and three-dimensional patterns “formed within” a solid material as called for by claim 12. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

17. Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 14 calls for the temperature changing element to be located “on said first external surface”. However, the original disclosure fails to describe or support such a location for the temperature changing element. Hence claim 14 is directed to new matter.

18. Claims 17-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled

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in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 17 calls for an activatable "self-enclosed" temperature changing element "disposed within said product" for heating the product. However, the original disclosure fails to describe or support such a self-enclosed temperature changing element or that the temperature changing element is disposed within the product. Hence claim 17 is directed to new matter.

19. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

A claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed.

20. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

21. <sup>drop if # 12 entered</sup> Claims 3 and 10 provide for the use of a semi-enclosed applicator, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

22. <sup>drop if # 12 entered</sup> Claims 1 and 13 contain a term lacking proper antecedent basis. The claims recite the limitation "said pouch" in line 10. There is insufficient antecedent basis for this limitation in the claims.

23. <sup>drop if # 12 entered</sup> Regarding claim 5, the phrase "and the like" renders the claim indefinite because the claim includes elements not actually disclosed (those encompassed by "and the like"), thereby rendering the scope of the claim unascertainable. See MPEP § 2173.05(d).



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24. Claim 15 contains a term lacking proper antecedent basis. The claim recites the limitation “said rupturable pouch” in line 1. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

25. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

26. Claims 1-7, 9, 10, 13, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sansonetti in view of Cahill. Sansonetti discloses a semi-enclosed applicator in the form of a mitten or glove for distributing a product having a first temperature onto a target surface having the claimed features including a first side having a first internal surface and a first external surface (constituted by the upper hand portion of the mitt 10), a second side having a second internal surface and a second external surface (constituted by the bottom hand portion of the mitt 10) wherein the first internal surface and the second internal surface form an internal cavity (constituted by chamber 16) therebetween, the internal cavity 16 having an opening that is externally accessible (note Fig. 1), a rupturable reservoir 18 containing the product 20 located proximate to the first internal surface (note Fig. 3), and an activatable temperature changing element (constituted by heating element 34) located proximate to the reservoir 18 (note Fig. 3) wherein the temperature changing element 34 changes the first temperature of the product upon activation and prior to the product being released from the reservoir 18 to the target surface through the first side. Sansonetti discloses that the product is released from the reservoir upon melting of the membrane 22 which seals the product within the reservoir (note lines 27-30 in col. 2). Although Sansonetti fails to disclose that the product 20 is released from the reservoir 18 in response to an application of pressure to the rupturable reservoir, attention is directed to Cahill who discloses another mitten or glove for use in the application of a

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hand cream having at least one product containing reservoir 3 sealed by a membrane 5 which ruptures when pressure is applied for that purpose (note lines 41-45 in col. 1) to effect a desired application of the hand-treatment vehicle or product to affected parts of the hand (note lines 2-5 in col. 2). It would have been obvious to one of ordinary skill in the hand care glove/mitten art, at the time the invention was made, to seal the reservoir of Sansonetti with a membrane that ruptures in response to pressure being applied thereto in view of the teachings of Cahill in order to better control the application of hand cream to specific affected parts of the hand. With respect to claim 2, Sansonetti also discloses that the temperature changing element 34 is located between the first and second internal surfaces of the mitten (note Figs. 2 and 3). With respect to claims 3, 4 and 10, Sansonetti further discloses that the applicator moisturizes and conditions skin to facilitate absorption of the hand cream (note lines 39-42 in col. 1). With regard to claim 5, Sansonetti additionally discloses that the product 20 is a hand cream, which creams are well known to contain such ingredients as emollients, oils and polymers. With respect to claim 6, the product 20 hand cream of Sansonetti inherently has shear-thinning or thixotropic properties since the heat aids in the absorption of the cream (note lines 39-42 in col. 1). With respect to claim 7, the product 20 hand cream of Sansonetti inherently has tactile properties such as greasiness or slipperiness. With respect to claim 9, Sansonetti additionally discloses that the first and second sides each comprise a functional side (note lines 6-8 in col. 1). With regard to claim 15, Sansonetti also discloses that the rupturable reservoir is provided with a frangible seal constituted by the membrane 22 having a resistance to bursting. With regard to claim 16, Sansonetti further discloses a barrier layer constituted by inner mitten 12 which is substantially impervious to the product and is disposed proximate to the first internal surface (note lines 23-27 in col. 2).

27. Claim 8 is rejected under 35 U.S.C. 103 as being unpatentable over Sansonetti in view of Cahill as applied to claims 1-7, 9, 10, 13, 15 and 16 above. Although Sansonetti fails to disclose the

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chemical composition of the product 20 hand cream, using such ingredients as petrolatum, petroleum jelly, castor oil, octocrylene, tocopheryl acetate or non-volatile organo-substituted polysiloxanes in the hand cream formula would be an obvious matter of choice to the artisan skilled in the hand cream art depending upon the brand of hand cream used since such ingredients are well known constituents of hand cream formulas.

28. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sansonetti in view of Cahill as applied to claims 1-7, 9, 10, 13, 15 and 16 above and further in view of Charos. Although Sansonetti fails to disclose that the applicator contains a massaging structure positioned behind the first external side, attention is directed to Charos who discloses another heated hand cream mitt or glove having cavities 2 or 10 on the inner side of the external side (note Figs. 1-3) in order to effect a suction-massage action (note lines 20-24 in col. 2). It would have been obvious to one of ordinary skill in the heated hand cream mitt or glove art, at the time the invention was made, to provide the inner side of the mitt of Sansonetti with cavities in view of the teachings of Charos in order to effect a suction-massage action.

### ***Response to Arguments***

29. Applicant's arguments filed May 22, 2003 (Paper No. 8) have been fully considered but they are not deemed persuasive.

30. Applicant's contend that page 8, lines 14-18, of the application provide support for the language "at least one opening". However, the above cited portion of the specification merely supports "at least one externally-accessible internal cavity". No mention of an opening is made at this particular portion of the specification.

31. Applicant's also contend that page 38, lines 6-22, of the specification provide support for the "temperature changing element". Although the above cited portion of the specification does indeed

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support a temperature changing element, it fails to provide support for such a temperature changing element to be used in conjunction with a mitt.

32. Applicant's further contend that page 41, line 4, and line 1 on page 45 to line 7 on page 53 of the specification provide support for the temperature changing element to be utilized with the claimed uses. However, the uses described from line 1 on page 45 to line 4 on page 48, from line 8 on page 49 to line 4 on page 50, and from line 10 on page 53 to line 24 on page 63 of the specification do not disclose that they include a temperature changing element.

33. Contrary to applicant's contention with regard to claim 12, the claim fails to describe "rotating or rolling" as functions of the balls, cylinders and rods.

34. Applicant's contend that claims 3 and 10 recite structural limitations. However, these claims recite only uses thereof rather than additional structure.

35. Applicant's argument that the Sansonetti reference is silent with regard to distributing a product contained within the reservoir to an external target surface has been carefully considered. However, it is pointed out that the reference does indeed disclose that the product contained within the reservoir is distributed to an external surface constituted by the hand inserted within the mitten (note lines 39-42 in col. 1).

36. Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

### ***Conclusion***

37. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

38. The Examiner is advising attorneys to FAX any response due to Office actions. The U. S. Patent and Trademark Office (USPTO) is experiencing major delays in matching up papers that were mailed. Due to the Anthrax issue, any mail sent to the USPTO is automatically sent to an irradiation center in Virginia. It has been found that the irradiation process makes papers too brittle to handle. Therefore, the irradiation center has to further copy each paper. The originally filed irradiated papers are then placed in a sealed envelope and put in the associated file. After this irradiation process, the "papers" are then sent to the Office where they are matched with the file. This entire procedure causes months in delays due to the quantity of mailed received. Therefore, it is suggested that any response be sent by FAX especially if a time limit is critical. The FAX number for the technical center where this file is located is given in the paragraph below.

39. Any inquiry concerning this communication from the examiner should be directed to Examiner Kathleen J. Prunner whose telephone number is 703-306-9044. The examiner can usually be reached Monday through Friday from 5:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson, can be reached on 703-308-2580. The FAX phone number for the organization where this application is assigned is 703-308-7766.

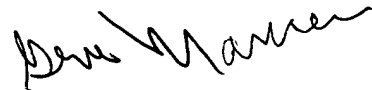
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Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-0861.



Kathleen J. Prunner:kjp

July 23, 2003



Gene Mancene  
Supervisory Patent Examiner  
Group 3700